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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 485,245	03 27 2000	ALISON HOPKINS	28911 36128	1697

7590 10 28 2002

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EXAMINER

WILDER, CYNTHIA B

ART UNIT PAPER NUMBER

1637

DATE MAILED: 10 28 2002

*92*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/485,245

Applicant(s)  
Hopkins, A

Examiner  
Cynthia B Wilder

Art Unit  
1637



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 1, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s): \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s): \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. Applicant's amendment filed in Paper No 21 is acknowledged and has been entered. Claim 1 has been entered. Claim 2 has been canceled. Claims 1, 3-6 are pending. Finality of the claims 1-6 is withdrawn in view of the new grounds of rejections.

#### *New Grounds of Rejections*

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Godiska et al. (5,759,804, filed November 17, 1993) in view of Shen et al. (EP 0 726 310 A1 February 09, 1996). Regarding claims 1, 3 and 4, Godiska et al teach a labeling composition comprising a random mixture of oligonucleotides which are 6-mers, wherein the composition further contains at least a supply of nucleotides for chain extension, a labeled nucleotide, and a polymerase enzyme (col. 8, lines 27-31). The labeling composition of Godiska et al differs from the instant invention in that Godiska et al do not expressly teach wherein the labeling composition is in a dry state. Shen et al teach a composition similar to that of Godiska et al present in a dry state (page 4, lines 37-41). Shen et al teach wherein the composition may comprise primers, a polymerase enzyme, a supply of

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nucleotides for chain extension, and a stabilizer (page 6, lines 3-7 and 22). Shen et al teach that the composition present in the dry state is advantageous because the composition is stable for a prolonged period, even when stored at high temperature. Shen et al further teach that a composition in a dried state is useful in shipping and storage of commercial preparations for use in e.g., nucleic acid amplification kits (page 6, lines 39-41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to have been motivated to provide the labeling composition as taught by Godiska et al in a dried state for the advantage taught by Shen et al that a nucleic acid composition present in a dried state is useful in shipping and storage of commercial preparations due its increase stability.

Regarding claim 5, Godiska et al teach a method of making a labeled probe for a nucleic acid template, wherein the method comprises the steps of providing a nucleic acid template and a labeling composition and incubating the nucleic acid template under chain extension conditions with the labeling composition to produce a labeled probe (col. 8, lines 27-31).

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Godiska et al. in view of Shen et al. and further in view of Hoeltke et al. (5,814,502, effective filing date October 1994). Regarding claim 6, Godiska et al in view of Shen et al teach a labeling composition and method of making a labeled probe comprising a number of method steps wherein the labeled compositions comprises a random mixture of oligonucleotides which are 6-mers and said composition present in a dry state. The labeling composition of the disclosure differs from that of the references in that the references do not expressly teach the concentration of the random mixture of oligonucleotides.

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However the optimal contents range would have been determined by the practitioner based on desired properties of the random oligonucleotides, desired lengths of the random oligonucleotides and desired results. For example, in a method for labeling nucleic acid, Hoeltke et al teach a random mixture of oligonucleotides wherein the concentration range of approximately 15 to 80 OD/ml is selected for the various random primers which are 6-mers to 15- mers. Hoeltke et al further teach that depending on the primer length, the optimal contents range will change (col. 2, lines 55-60 and col. 3, lines 38-42). Therefore, in view of the foregoing, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made that the concentration range of the random mixture of oligonucleotides is variable based the practitioner's preference as well as the length of the primers as suggested by Hoeltke et al.

### ***Conclusion***

5. No claims are allowed.
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Cynthia Wilder whose telephone number is (703) 305-1680. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

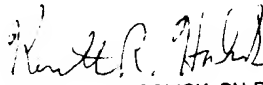
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached at (703) 308-1119. The official fax phone number for the Group is (703) 308-4242. The unofficial fax number is (703) 308-8724.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group's Patent Analyst, Monica Graves at (703) 305-3002 or Group's receptionist at (703) 308-0196.

Cynthia B. Wilder, Ph.D.

October 10, 2002

  
KENNETH R. HORLICK, PH.D.  
PRIMARY EXAMINER

10/17/02